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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,087	10/04/1999	GARY L. BURGE	CIS1365-171C	9198

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

MAIL DATE	DELIVERY MODE
08/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/412,087	BURGE ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *6-15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5 and 16-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 October 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemon et al. (US pat. 4,674,041) in view of Herz et al. US005835087A.

3. Lemon et al. teaches (independent claims 1 and 16) a system for customizing displays and an electronic marketing system, the electronic marketing system comprising:

a plurality of electronic user profiles (*customer credit account numbers and coupon transaction histories* stored in *memory* ***56***, col. 8 lines 32-37);

a database (*memory* ***56***) for storing *coupons to be displayed* (col. 8 lines 32-36), the merchant-selected details of said *coupons* reading on merchant data for a plurality of merchants (col. 3 lines 36-38 and 61-62);

variable display characteristics (*full screen advertisements* or *a page formatted menu of coupons*, col. 6 lines 62-67) for defining the layout of a computer display;

a predictive model for selecting actual display characteristics consistent with said variable display characteristics (i.e., selecting the sequence and number of pages for display of coupons and ads, col. 5 lines 32-44), said actual display characteristics independent of said merchant data (i.e., independent of the details of the coupons offered by merchants to the customer user), and conforming to monitored user preferences (the *coupon transaction histories*) for presentation of merchant data (the merchant-selected details of the coupons) on said computer display (col. 5 lines 8-11) in accordance with one of said electronic user profiles/*coupon transaction histories*; and

a computer display comprising said actual display characteristics and said merchant data from said plurality of merchants, said computer display conforming to monitored user

preferences/*coupon transaction histories* based on said actual display characteristics for presentation of said merchant data.

4. For claim 1, Lemon et al. also teaches a process at a host computer (*host computer H*) for selecting a plurality of actual display characteristics (col. 4 lines 35-40), and a "shopper's computer" (*terminal T with customer interface*, col. 4 lines 15-22 and Fig. 2).

5. Lemon et al. does not teach on-line purchasing, a computer located remotely from the point of sale and connected to a host computer via an on-line subscription service. Herz et al. teaches on-line purchasing (col. 70 lines 22-28), a computer (*personal computers* T_1-T_n) located remotely from the point of sale and connected to a host computer via an on-line subscription service (*America Online*, col. 28 lines 47-66). Because Herz et al. teaches how relevant information can be found on-line without requiring the user to expend an excessive amount of time and energy (col. 1 lines 46-62 and col. 4 lines 37-43), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Herz et al. to those of Lemon et al.

6. Lemon et al. also teaches at the citations given above claims 2, 5 and 18. Claim 2 does not add a patentable, structural, limitation to claim 1. Even if it did, the plurality of *terminals T* (col. 4 lines 15-22) would read on "selected sites".

7. Lemon et al. does not teach (claims 3 and 17) that personal data includes age, sex and hobbies. Official notice is taken (MPEP § 2144.03) that it was common, at the time of the instant invention, to monitor these demographic parameters for marketing purposes. Lemon et al. also does not teach (claims 4, 19 and 20) that the coupons/display model parameters include colors. It was common, at the time of the instant invention, to produce colored coupons.

8. Official notice of these common knowledge or well known in the art statements was taken in the last Office action mailed on 6 February 2006 (para. 15 and 16). These statements are taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. (MPEP 2144.03.C.)

Response to Arguments

9. Applicant's arguments filed with an amendment on 8 June 2007 have been fully considered but they are not persuasive.

10. Applicant argues (p. 11 of 16, center) that Lemon et al., col. 6 lines 62-67, does not teach variable display characteristics for defining the layout of a computer display. As noted in para. 3 above, the reference citation teaches *full screen advertisements* or *a page formatted menu of coupons*; these two display options read on variable display characteristics for defining the layout of a computer display. Applicant also argues that these options "do not relate in any way to user preferences for **presentation** of content data." But, they do: one option when the user prefers to see ads and one option when the user prefers to see coupons. Applicant argues further (bottom of p. 11 of 16) that there are no "display model parameters". But, there are: whether or not the customer activates switch "A" is a parameter (col. 5 lines 38-44).

11. Applicant argues (p. 12-13 of 16) that Lemon et al., col. 5 lines 32-44, does not teach a predictive model, but applicant does not address the detailed explanation given in para. 3 above. Applicant's argument does not comply with the requirements of 37 CFR 1.111(b). Applicant has not specifically and distinctly pointed out the supposed errors, in substance, of the rejection. The applicant's argument is a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentable distinguishes them from the references.

12. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...". An example does not constitute a "clear definition" beyond the scope of the example.

13. The instant application contains no such clear definition for any of its terms, including "variable display characteristics", "a predictive model" and "actual display characteristics". Hence, the examiner has given each of these terms their broadest reasonable interpretation.

14. "Variable display characteristics" are interpreted as any display layout option. Lemon et al. teaches that as the advertisement versus coupon format display options (*full screen* versus *page formatted* options, col. 6 lines 62-67).

15. "A predictive model" is interpreted as any mechanism for

"selecting actual display characteristics consistent with said variable display characteristics" (selecting the sequence and number of pages for display of coupons and ads, col. 5 lines 32-44),

"said actual display characteristics independent of said merchant data" (i.e., independent of the details of the coupons offered by merchants to the customer user), and

"conforming to monitored user preferences" (the *coupon transaction histories*) "for presentation of merchant data" (the merchant-selected details of the coupons) "on said computer display" (col. 5 lines 8-11) in accordance with one of said electronic user profiles/*coupon transaction histories*.

16. As noted in the last para. "actual display characteristics" is interpreted as any characteristic of the display, which is taught in Lemon et al. as the sequence and number of pages for display of coupons and ads (col. 5 lines 32-44).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The

examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.

20. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. **AFTER FINAL PRACTICE –** Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

23. Applicant may have after final arguments considered and amendments entered by filing an RCE.

24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

Donald L. Champagne
Primary Examiner
Art Unit 3622

9 August 2007

DONALD L. CHAMPAGNE
PRIMARY EXAMINER